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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,728	08/05/2003	David M. Chess	YOR920030230US1	8862
29683	7590	08/26/2005	EXAMINER	
HARRINGTON & SMITH, LLP 4 RESEARCH DRIVE SHELTON, CT 06484-6212			CHOULES, JACK M	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/635,728	Applicant(s) CHESS ET AL.	
	Examiner Jack M. Choules	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/8/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-33 are presented for examination. Claims 32 and 33 having been added by amendment filed 23 May 2005, this office action is in response to the amendment and arguments provided.

Response to Arguments

2. Applicant's arguments filed 26 July 2005 have been fully considered but they are not all persuasive as noted below. The applicant in response to the rejection under 101 that "a source of data... coupled to said query component" and a "submitted query database" refer to tangible computer elements and thus are statutory. Note: the examiner agrees that the processor, as recited in the claims, is a tangible element and produce results that are useful concrete and tangible.

3. The examiner respectfully responds that although these elements may concern tangible elements as argued the breadth of the terms also allows them to be construed as software components for example in claim 18 the submitted query database may be construed to refer to the Data base management system which is software and comprises a portion which handles queries. The examiner finds no definition in the specification that requires the submitted query database to be tangible.

4. As to claim 30 there is no elements are found that are necessarily tangible for example means for storing computer relevant data may refer to a software means for that purpose. While the means plus function claim may be read on means in the specification applicant has not specified the particular element of the specification that each means refers to.

5. Further in claim 31 the communications interface could be software for receiving a meta-query or for receiving enhanced performance information from the server, the communications device could thus refer to the same software, the examiner finds no definitions in the specification requiring these terms to refer to a tangible element. For the reasons above the examiner maintains the rejections under 101 on claims 18-19, 30, 31, and extend it to claims 32.

6. In respect to the rejections under 102 and 103 the applicant argues that “Applicant’s invention generally concerns the gathering and distribution of information concerning for example, the reliability of the entities to a business transaction...” which as the terms are defined in the specification is distinct from what is taught by Osborn’s patent.

7. The examiner respectfully replies that the claims cannot be allowed based on the general meaning of the terms in the claims. If a term “generally refers” to a meaning it means that it can specifically have other meanings outside of the general meaning, thus the definitions are not definite. Thus if the examiner applied the quoted definitions to the claims he would have to reject them all under 112 for not being able to determine the specific meets and bounds of any of the claims. Rather the examiner has interpreted the specific meanings that are outside of the general meaning to be the general accepted meaning of these terms in the data processing art, which do not limit to business transactions. And since the examiner is charged with examining the claims with the broadest possible interpretation definitions that start with “generally refers to,” “typically,” and for “example” do not include the broadest interpretation as they do not define all possible meanings or even give an indication thereof. Further an “example” apparently is an intended embodiment not a definition.

8. The applicant argues in respect to the 102(B) rejection over Osborn that the Osborn patent merely showed the time and not the probability that a transaction will be a success.

9. The examiner respectfully argues that the length of time used by the query is “data relevant to the probability that a transaction with an entity will be successful” transaction using the query as a specific transaction and the database as the entity (although this does not fit the definition that ‘generally’ applies: see the arguments herein above with reference to the general nature of the definition) the purpose of the invention of Osborn was to improve systems that timed out queries by returning the time to do the query so it could be determined what chance the query had of completing. “If a response is not returned in by the system before a preset time limit is reached, the DBMS abandons any further execution of the query, leaving the user with no result whatsoever,” and “Thus it would be desirable to provide an up-front estimation of the system response time required for returning a response time required for returning a response to an individual database query prior to their actual execution,” (column 1, lines 43-62). Thus the estimated time the query will run is “relevant to probability that a transaction with an entity (Webster’s II New Riverside University Dictionary © 1984,1988 something that exists as a particular or discrete unit)

10. Applicant argues that Osborn does not suggest a “meta-query component” as claimed.

11. The examiner respectfully disagrees as Osborn (column 6, lines 37-64 and figure 3) shows that the query results in a returning of the types and times of the previous queries to “a query performance module (“QPP”)” where they all are used to produce an current estimated time based on the actual time of the query. As the query returns data about previous queries (there actual execution time) it is a meta query, the portion of Osborn system that provides the time information from passed queries to the QPP is thus the Meta query-component.

12. In reference to the rejection under 102(e) over Moore applicant argues in reference to claim 1 that “It is not seen how a system that only generates results in a single state (i.e., match)

concerns methods and apparatus that provide probabilities that a future transaction with an entity will be successful based on data gathered concerning past transactions with that entity.

13. First it is clear that the system of Moore generates two states those matches that are returned, with a high probability of success, and non-matches that are not returned with a low probability of success (column 6, lines 41-67 and column 7 lines 1-17). Further claim 1 states “data relevant to the probability” there are no terms in the claim 1 that requires that the actual probabilities are provided nor is there any clear definition that so require (see discussion of cited definitions above”), nor does the examiner find language requiring the exercising of business judgment to decide to transact, nor any requirement for business reputation information or a lack of trustworthiness. And examiner will not find a claim allowable based on example and not the specific language of the claims and precisely definition of the terms with clear meets and bounds.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 18-28 and 30-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:**

3. Claims 18-19, and 30-32 are directed to “A performance prediction system” that is clearly a data structure Per Se and/or a computer listing Per Se. Thus being descriptive material Per Se and hence nonstatutory (see MPEP 2106 IV B 1 (a)).

From MPEP 2106 IV B 1 (a). Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

4. And claims 20-28 are directed to a corresponding “method to provide performance prediction information,” performed on data structures Per Se and or computer listings Per Se. The separate steps of the claims, for example receiving queries, are assumed to be preformed in software on data structures. The examiner finds no limitation in the claims to hardware or other physical structure and no limitation of the claims that is defined in the specification, as being

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physical structures as software and data is not considered a physical structure. See the PMEP section 2106 IV B 1 (a). The courts have held in *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), wherein claims to a data structure stored in memory were held to be statutory subject matter because of the statutory nature of the memory. However, as no memory or other physical structure is claimed in the claims recited Lowry does not control the examiners decision to reject. The "method to provide performance prediction information," is considered to be broad enough to include mental steps or manipulation of abstract ideas as no physical structure is claimed on which to apply the acts (see MPEP 2106 IV B 1).

From MPEP 2106 IV B 1. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Schrader*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 2, 11-15, 18-22, and 25-33 are rejected under 35 U.S.C. 102(b) as being anticipate by Osborn et al. [hereinafter Osborn et al] US Patent No. 6,026,391.**

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7. As to claims 1, 13, 18, 20, 29, 30-33, Osborn et al. teaches a system comprising: “at least one memory”; (Fig. 1B, indexes 8-10) “a query component for receiving queries submitted by users” (column 6, lines 1-22) “for data relevant to the probability that a transaction with an entity will be successful” (column 6, lines 23-50 and column 1, lines 43-62); “a data gathering component for storing relevant data about submitted queries” (column 6, line 51-67 and column 7, lines 1-16); and a meta-query component responsive to a meta-query for returning information regarding previously submitted queries” (column 7, lines 7-58); “at least one data processor” (fig. 1B, index 7). Using the text of claim 1, other claims rejected are considered to have similar element disclosed by the same prior art cited.

8. As to claims 2 and 19, Osborn et al. teaches a system further comprising: “a performance-prediction component that uses data comprising including the stored submitted query data in making estimations relevant to the likelihood of success of a transaction involving an entity will be successful” (column 7, lines 7-58 and column 1, lines 43-62). Using the text of claim 2, other claims rejected are considered to have similar element disclosed by the same prior art cited.

9. As to claim 11, Osborn et al. teaches a system further comprising: “the performance prediction component determines statistical correlations between patterns of submitted queries (column 7, lines 17-35).

10. As to claims 12, 14, 15, 21, and 22, Osborn et al. teaches a system further comprising: “where the performance prediction component further uses one of actual and predicted performance of entities, and uses the statistical correlations to predict likely future performance based on past and present query data” (column 7, lines 7-35).

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11. As to claim 25, Osborn et al. teaches a system further comprising: “collecting query-relevant data comprising at least one of time, date, location, and identity” (column 6, lines 51-64).

12. As to claim 26, Osborn et al. teaches a system further comprising: “filtering the enhanced performance prediction information to remove at least some of the collected query-relevant data” (column 7 lines 7-58) only estimated time returned therefore rest of data was filtered.

13. As to claim 27, Osborn et al. teaches a system further comprising: “further comprising registering for automatically querying the acquired Knowledge” (column 2 lines 1-23 and column 7, lines 7-35) incorporating the QPP is considered registering for automatically querying.

14. As to claim 28, Osborn et al. teaches a system further comprising: “where automatic querying is initiated upon the occurrence of at least one specified criterion” (column 2 lines 1-23 and column 7, lines 7-35) the specified criterion is receiving a query from the user.

15. **Claims 1, 2, 6-8, 11, 13, 18-20, 25, 26, and 29-33, are rejected under 35 U.S.C. 102(e) as being anticipate by Moore US Patent No. 6,847,938.**

16. As to claims 1, 13, 18, 20, 29, 30, and 30-33, Moore et al. teaches a system comprising: “at least one memory” (figure 1, index 6); “a query component for receiving queries submitted by users for data relevant to the probability that a transaction with an entity will be successful” (column 6, lines 41-67 and column 7, lines 1-17) note the search is for a entity that has entered the reciprocal search which would lead to a high probability of successful transaction between the user and entity; “a data gathering component for storing relevant data about submitted queries” (column 7, line 6-17); a meta-query component responsive to a meta-query for returning

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information regarding previously submitted queries” (column 6, lines 41-67 and column 7, lines 1-35) and “at least one data processor” (figure 1, index 5). Using the text of claim 1, other claims rejected are considered to have similar element disclosed by the same prior art cited.

17. As to claims 2 and 19, Moore teaches a system further comprising: “a performance-prediction component that uses data comprising including the stored submitted query data in making estimations relevant to the likelihood of success of a transaction involving an entity will be successful” (column 7, lines 18-35). Using the text of claim 2, other claims rejected are considered to have similar element disclosed by the same prior art cited.

18. As to claim 6, Moore teaches a system further comprising: “the meta-query component allows a user to register to be notified at some future time of submitted queries that are received about that user” (column 9, lines 41-63).

19. As to claim 7, Moore teaches a system further comprising: the meta-query component allows a user to register to be notified whenever a specified number of queries about that user have been submitted to the system (column 9, lines 41-63) the specified number of queries is one.

20. As to claim 8, Moore teaches a system further comprising: “the query component also comprises a discovery component that allows users to receive a list of entities that satisfy certain criteria. (column 7, lines 46-58 and column 9, lines 10-24).

21. As to claim 11, Moore teaches a system further comprising: “the performance prediction component determines statistical correlations between patterns of submitted queries (column 7, lines 18-25).

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22. As to claim 25, Moore teaches a system further comprising: “collecting query-relevant data comprising at least one of time, date, location, and identity” (column 6, lines 41-63).

23. As to claim 26, Moore teaches a system further comprising: “filtering the enhanced performance prediction information to remove at least some of the collected query-relevant data” (column 10 lines 1-28) only estimated time returned therefore rest of data was filtered.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

26. Claims 3, 4, 9, 10, 16, 17, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore US Patent No. 6,847,938.

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27. As to claims 3, 4, 16, 17, 23, and 24, Moore teaches a system further comprising: “the meta-query component returns” info from queries (column 9, lines 25-40).

28. Moore does not specify that this is a “copy” or “edited copy” of the claim. However, the recorded queries are essentially records being stored in a data base and it is known to return copies or edited copies of the claims in order to would have been obvious to one of ordinary skill in the art to provide a copy or edited copy as this would consist of simply displaying what is stored and in order to decide whether offer is acceptable applicant must see at least a portion of the query which would be provided by edited copy (column 9, lines 25-40) as is shown by claims.

29. As to claims 9 and 10, Moore does not teach “businesses,” however, it would be obvious for “businesses” to be considered the users. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention as “businesses” would also find it useful to trade there recourses and or equipment. If the users are considered to be businesses then Moore discloses returning info on records matched to users over a period of time (time from when query entered until records returned (column 9, lines 10-24 and 41-63). Further the it would be obvious to return records on queries not related to the business (or user) as that would merely be the records from the period not returned as related to the business and would be advantageous as the business would be able to see what the competition was up to.

30. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore as applied to claim 1 above, and further in view of Kirkpatrick Patent Application Publication US 2002/0059258.

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31. As to claim 5, Moore does not detail “an indication of a number of queries that have been submitted to the system during a particular time period”, however, Kirkpatrick describes a system where “an indication of a number of queries...” (page 4, paragraph [0037]).

32. . It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine Kirkpatrick with Moore because doing so allows the tracking of the number of queries entered or the number entered with a particular term

Conclusion

33. Applicant's amendment necessitated the new (modified) ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

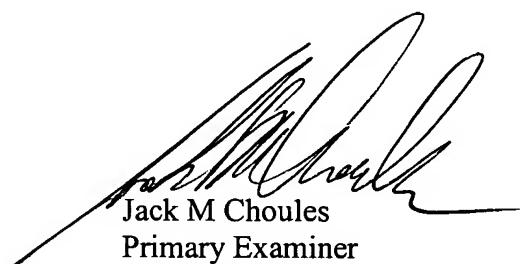
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M. Choules whose telephone number is (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules
Primary Examiner
Art Unit 2167

JMC